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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,231	12/05/2003	Roger Thomas	P-US-PR 1107	9218
28268	7590	04/04/2006	EXAMINER	
THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,231

Applicant(s)

THOMAS, ROGER

Examiner

Shelley Self

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

The amendment filed on January 13, 2006 has been considered but is ineffective to overcome the prior art reference.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

As noted in the previous Office Action, claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5, 8, 9 and 11-18 of copending Application No. 10/729204. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely re-worded. For example, the claims of the presently presented application are drawn to a debris collection container for a planer comprising a receptacle having a first and second rigid section and deformable section there between and a connector. The claims of the co-pending application are also drawn to a debris collection container comprising a receptacle (clm. 1)

Art Unit: 3725

having a first and second rigid section and deformable section (clm. 13, 14) there between and a connector. Accordingly, the claims as presented fail to set forth any distinguishing structure over that of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Schneider (6,520,365) as noted in previous Office Action. With regard to claims 1, 2, 4-6, 8, 10 and 14, Wang discloses a debris collection container for a planer (fig. 2) which employs a stream of air to remove debris generated by the planer (4), the debris collection container comprising: a receptacle for storage of the debris (5); and a connector (fig. 4) connectable between the receptacle (5) having a first rigid section (50) and the planer (fig. 2) defining a path for debris passing from the planer to the receptacle. Wang does not disclose the receptacle having a second rigid section with a deformable section located between and connecting the first rigid section and the second rigid section, or the first rigid section can be releasably attached to the second rigid section when the deformable section is in a compressed condition. Schneider teaches a specific type of receptacle for storage of debris. Schneider

Art Unit: 3725

teaches a receptacle (fig. 1) having a first rigid section (14), a second rigid section (16, 28) and a deformable section (12, 18) of transparent material located between and connecting the first rigid section and the second rigid section (figs. 1, 2), the deformable section (12, 18) includes a helical spring (20) and is manipulatable between a compressed condition and an expended condition (figs. 1, 2); wherein the first rigid section (14) defines an aperture and can be releasably attached to the second rigid section (16, 28) when the deformable section is in a compressed condition (fig. 2) and wherein the first rigid section is adjacent to the second rigid section. Schneider teaches this construction of a storage/debris receptacle so as to allow efficient storage of the receptacle when not in use. Because both Wang and Schneider teach debris/storage receptacles, it would have been obvious at the time of the invention to replace Wang's receptacle (5) with a collapsible receptacle (i.e. first and second rigid sections) so as to facilitate compact and efficient storage of the receptacle when not in use as taught by Schneider.

As to the loop, (clm. 3), Schneider discloses a loop and catch (64, 66) included on the first and second sections (14, 16) for releasably attaching the first section (14) to the second section (16, 28).

With regard to claim 7, Wang discloses a cap (fig. 4), releasably attached to the receptacle (5) for sealing the aperture (fig. 1, 2, 4).

With regard to claim 9, Wang discloses a first rigid section (50) including a rim (col. 2, lines 19-21) and the cap (fig. 4) releasably attached to the rim.

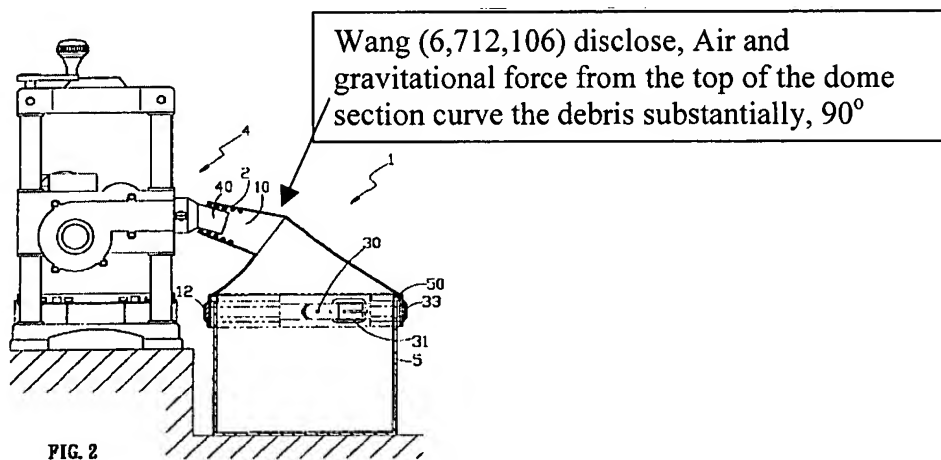
With regard to claim, Wang disclose the cap releasably attached to the receptacle (fig. 1, 2, 4).

With regard to claim 13, Wang discloses the connector integrally formed with the cap (fig. 4).

As to the transparent window (clm. 14), Examiner notes that Schneider teaches the use of various materials for the connector (col. 3, lines 11-27), one such material being any synthetic or man-made flexible material. Examiner notes, many transparent materials to be synthetic materials, such as polypropylene. Because Applicant has not stated a specific type of transparent material, Examiner notes Schneider to teach construction using transparent material.

With regard to claim 15 and 16, Wang discloses a part spherical shaped section (10; fig. 2) that curves the path of the debris as it passes through the part spherical section.

As to the 90 degrees (clm. 16) Examiner notes that the spherical section (10) curves the path of the debris and that some of the debris will follow the spherical section (10) to a highest most point and fall by air and gravity force downward, i.e., at a 90 degrees (fig. 2).



Claim 17 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Liao et al. (6,481,475) and Schneider (6,520,365). As noted above with reference to claim 1, Wang discloses, a planer having a planer body (fig. 2), receptacle (5), cap (fig. 4) and conduit for removal of debris. Wang does not

Art Unit: 3725

disclose a cutting drum rotatably mounted in the planer body, however it is obvious that the planer apparatus has a means for cutting so as to planarizer a work piece. Liao teaches in a similar art, a planer (fig. 2) having a planer body, debris exhaust conduit (43) and rotatable cutting member (35) mounted within the planer body.

Schneider teaches as noted above a receptacle having a first and second rigid section and deformable section there between.

Because both Wang and Liao are from a similar art and deal with a similar problem (i.e., collecting/storing debris from a planer apparatus/device) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Wang's means for cutting with a rotatable cutting member as taught by Liao so as to efficiently planarizer a work surface.

Further, it would have been obvious for the reasons set forth with regard to claim 1 to replace, Wang's receptacle with a collapsible receptacle (i.e., first and second rigid sections and deformable section there between) as taught by Schneider so as to efficiently store the receptacle when not in use.

### ***Allowable Subject Matter***

Claim 12 appears to contain allowable subject matter and is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the Double Patenting rejection(s) were overcome.

The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record does not disclose or fairly suggest a debris collection container for a

Art Unit: 3725

planer comprising a means for connecting comprising a first part including two pegs and a second part having a T-shaped slot, wherein one of the first part and the second part is mounted on the receptacle and the other of the first part and the second part is mounted on the cap in combination with the rest of the claimed limitations as set forth in claim 12.

The prior art reference, Wang discloses a connector (80) having rails, connection plates (81) and grooves (801) such that the plates (81) are positionable within the grooves (801) of the rails (80) so as to connect the cap (fig. 4) to the receptacle (5). Further, Wang discloses that the cap (fig. 4) is connected to the receptacle by the fastening member (31, 33, 300). Wang does not disclose or fairly suggest first and second parts having pegs and T-shaped slots wherein a one of the first and second parts is mounted on the receptacle and the other of the first and second parts is mounted on the cap. Instead, Wang discloses that the means for connecting the cap to the receptacle is mounted on the cap (fig. 4) with a flange (50) on the receptacle to correlate with the rails (80) and fastening means (33). Accordingly, Wang fails to anticipate or render obvious the claimed invention as set forth in claim 12.

Neither the prior art of record nor any combination thereof discloses the claimed invention as set forth in claim 12. Therefore claim 12 contains allowable subject matter over the prior art of record and would be deemed allowable if re-written to encompass all of the subject matter of the parent claim(s) and if the Double Patenting Rejection(s) were overcome.

### ***Response to Arguments***

Applicant's arguments filed January 13, 2006 have been carefully considered but they are not persuasive. Applicant's remarks are drawn to an improper combination of the prior art



Art Unit: 3725

references, Wang and Schneider. Applicant argues that Wang and Schneider are not analogous art and therefore cannot be combined. For example, Applicant states “*Wang and Schneider are in different fields of endeavor and are solving different types of problems. Wang is related to a dust bag...attached to a wood working machine to collect dust and wood shreds...Schneider is not designed to be connected to any device and is not designed to collect any items output from any type of device. Instead, Schneider is open at the top for a person to put items into the container.*” This argument is not found persuasive, because although the means for which items are placed in the collection containers differ (deposited via a machine vs. deposited via an operator), both devices are for the purposes of collecting and containing items/debris. Furthermore, Wang is also open at the connection point to the woodworking machine so as to allow the debris from the machine to be placed into the container, without an opening no debris would be able to be placed in Wang’s container. Because the references are solving a similar problem, i.e. collection of items into a container the container having an opening or pass through area of which to allow items/debris to be deposited into the containers the references are analogous. The depositing means (i.e., operator vs. machine) are not germane to patentability. Thus proper combination of the references is made and the rejection(s) stand.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


Art Unit: 3725

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf  
March 22, 2006



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